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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,560	06/12/2006	Rainer Aufischer	AUFISCHER ET AL-1 PCT	1583
25889	7590	08/27/2009	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			PILKINGTON, JAMES	
			ART UNIT	PAPER NUMBER
			3656	
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			08/27/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,560	<b>Applicant(s)</b> AUFISCHER ET AL.	
	<b>Examiner</b> JAMES PILKINGTON	<b>Art Unit</b> 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Prosecution Application*

The RCE filed on July 31, 2009 is acceptable and an action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norito, US PGPub 2003/0180572.

Norito discloses a bearing for reducing friction with a support shell (2a) and a sliding layer (2b) made of a bearing metal (see paragraph 0020) which is applied to the support shell (2a), wherein the sliding layer (2b) carries a cover layer (4), wherein the cover layer (4) forming the running layer differs optically from the sliding layer (2b, 2b is a metal of aluminum, copper or bronze which differs optically from the cover layer which is made of silver and an amorphous carbon to form a solid lubricant) and wherein the cover layer comprises of a sliding lacquer. Norito also discloses sizing the cover layer (4) between 10 and 20  $\mu\text{m}$  with a wear amount of approximately 6  $\mu\text{m}$  is expected. Sizing a layer to be more than the expected wear will cause the cover layer to wear away no later than the time at which the sliding layer experiences breakage.

Norito does not disclose that the average service life of the slide layer is used to calculate the initial thickness of the cover layer.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to calculate the initial thickness of the cover layer based on the average desired service life and particular load condition, since designing a component to last a particular service life period based on particular parameters, such as time and loading, is a known engineering design technique. Such a determination is only a matter of discovering an optimum value for a result effective variable and involves only routine skill in the art.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norito '572 in view of Braus, USP 4,847,135.

Norito discloses all of the subject matter as applied above.

Norito does not disclose that the cover layer is covered by a sliding lacquer on the basis of graphite or molybdenum sulfide.

Braus teaches that the use of graphite or molybdenum sulfide as a coating surface (C3/L27-48) for the purpose of improving the friction and sliding properties of the bearing (C3/L27-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Norito and provide a layer on the cover layer which is a sliding lacquer on the basis of graphite or molybdenum sulfide, as taught by Braus, for the purpose of improving the friction and sliding properties of the bearing.

### ***Response to Arguments***

Applicant's arguments filed 7/31/09 have been fully considered but they are not persuasive.

The Applicant argues that Norito does not disclose calculating the initial thickness of the cover layer as claimed and such a feature permits recognition of when a changing of the bearing is necessary.

As amended in the rejection above calculating an initial thickness of a cover layer based on a desired or expected service life would have been obvious to one having ordinary skill in the art. At the time the cover layer wears away there will be a difference in the appearance of the bearing since Norito discloses two different materials. The use of two different materials permits recognition of when the changing of the bearing is necessary (i.e. the cover layer is worn).

The Applicant argues that Norito discloses a system where the cover layer continues to wear after metal breakage and references Norito's Table 4 as evidence of this.

Norito's Table 4 is not considered with a time at which metal breakage occurs. Table 4 is expressing a limit pressure for preventing fatigue breakage. Table 4 does not address a pressure or when breakage occurs. Using the bearing below the upper limit surface pressure for preventing fatigue breaking will provide a bearing which has a cover layer which completely wears prior to breakage of the slide layer which will happen when there is a metal on metal contact with no solid lubricant (cover layer) therebetween.

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The Applicant argues that Norito does not address that the cover layer could undergo unexpected wear and tear and that not only do the wear and tear of the cover layer, but also the fatigue of the slide layer, depend on the loading.

These features are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/  
Examiner, Art Unit 3656  
8/26/09

/Thomas R. Hannon/  
Primary Examiner, Art Unit 3656